

Appl. No. : 09/890,416
Filed : July 27, 2001

REMARKS

Claims 1, 11, 19, and 28 have been amended. As a result, Claims 1-3, 7-11, and 19-29 remain pending in the present application. Support for the amendments is found in the existing claims and specification and claims as filed. Accordingly, the amendments do not constitute the addition of new matter. Reconsideration of the application in view of the foregoing amendments and following comments is respectfully requested.

Rejections under 35 U.S.C. § 112

The Examiner rejected Claim 28 under 35 U.S.C. § 112, second paragraph, as being indefinite. According to the Examiner, the phrase "hypertension or the disease resulting from hypertension" did not have sufficient antecedent basis. Claim 28 has been amended to recite "cerebral apoplexy" which has sufficient antecedent basis.

Accordingly, Applicants respectfully request the Examiner to reconsider and withdraw the rejection under 35 U.S.C. § 112, second paragraph.

Rejections under 35 U.S.C. § 102

The Examiner rejected Claims 19, 26, 27, and 29 under 35 U.S.C. § 102(b) as being anticipated by Ruf et al. Ruf et al. (Arteriosclerosis, Thrombosis, and Vascular Biology) discloses that wine and grape seed extract exert a protective effect against platelet aggregation.

According to M.P.E.P. 2131, a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.

Claim 19 has been amended to recite, *inter alia*, "at least one member selected from the compound represented by Formula (I) or a multimer thereof from about 0.1 mg per day to about 20 mg per kg per day." Support for this amendment can be found in the specification on page 32, line 1 and page 34, line 23. Ruf et al. does not recite these dosages. Ruf et al. discloses that rats with body weight of 150 to 175 grams were given free access to beverage and diet. Calculation of the dosages of resveratrol needed for the rats in the recited ranges of Claim 19 is 0.015 mg to 3.5 mg per day per rat. One of the beverages administered to the rats is red wine with 0.025% grape seed extract containing tannins. Therefore, even if all the tannins were resveratrol, a rat

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would need to consume 6000 to 1,400,000 mg of wine, which is unrealistic amount of wine for a rat to consume in one day. Accordingly, Ruf et al. does not anticipate Claims 19, 26, 27, and 29.

Accordingly, Applicants respectfully request the Examiner to reconsider and withdraw the rejections under 35 U.S.C. § 102(b).

Rejections under 35 U.S.C. § 103

The Examiner rejected Claims 1 and 7-10 under 35 U.S.C. § 103(a) as being unpatentable over Hirschberg (WO 99/35917-A1). Hirschberg discloses methods for infusing compositions including phytochemicals and nutraceuticals into foods products.

According to M.P.E.P. 2143.03, to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art.

Claim 1 has been amended to recite, *inter alia*, “0.1 to 5% by weight of at least one member selected from a compound represented by Formula (1) or a multimer thereof.” Support for this amendment can be found in Examples 1, 2 and 5 and on page 22, line 24 of the specification. Support for the amendment of Claim 1 to recite “dentifrices, liquid dentifrices, mouthwashes, and oral liniments” can be found on page 29, lines 13-14 of the specification. Hirschberg does not teach or suggest a composition comprising the recited amount of a compound of Formula I. Accordingly, Claim 1 is patentable over Hirschberg.

Accordingly, Applicants respectfully request the Examiner to reconsider and withdraw the rejections under 35 U.S.C. § 103(a).

Consideration of Claims 11, 20-25

The Examiner withdrew Claims 11 and 20-25 as being directed to an invention that is independent or distinct from the invention originally claimed. Previously presented Claims 11 and 20-25 were directed to “a method for preventing or treating diseases accompanied by a decrease in bone weight.” In the previous Amendment, Claims 11 and 20-25 were amended to be directed to “[a] method for increasing breaking load and breaking energy without significantly increasing bone density.” The Examiner stated that Claims 11 and 20-25 exclude the subject matter since bone density is increased by increasing bone weight. Applicants wish to note that the previous language does not require an increase in bone density.

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Nevertheless, in the present paper, Claims 11 and 20-25 are amended to recite “[a] method for preventing or treating diseases accompanied by a decrease in bone weight” which was previously considered as part of the elected invention. Accordingly, Applicants respectfully request the Examiner to consider Claims 11 and 20-25 as part of the elected invention and provide examination of these claims.

Novelty of Claims 11 and 20-25

Furthermore, Claims 11 and 20-25 are novel and patentable over the cited prior art in the Office Action dated October 22, 2002. Because these claims were withdrawn in the most recent Office Action, the Examiner has not yet considered Applicants’ response to the rejection of these claims in the Office Action dated October 22, 2002. In that Office Action, the Examiner rejected Claim 11 under 35 U.S.C. § 102(b) as being anticipated by CN 1127070.

According to M.P.E.P. § 2131, a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.

CN 1127070 discloses a laundry list of ingredients for a composition and asserts numerous conditions that can be treated with administration of the composition. CN 1127070 specifically discloses that resveratrol can “reduce the fat content in the human body as a whole and the cholesterol content in blood.” CN 1127070 does not disclose methods for preventing or treating diseases accompanied by a decrease in bone weight with administration of a compound of Formula I. Therefore, CN 1127070 does not anticipate Claim 11.

Nonobviousness of Claims 11 and 20-25

In the same Office Action, the Examiner rejected Claim 11 under 35 U.S.C. § 103(a) as being unpatentable over Mizutani et al., Caspar et al., and CN 1127070.

According to M.P.E.P. 2143.02, the prior art can be modified or combined to reject claims as prima facie obvious as long as there is a reasonable expectation of success.

The Examiner relied on Mizutani et al. to show that resveratrol directly stimulates cell proliferation and differentiation of osteoblasts *in vitro*. Similarly, the Caspar reference discloses the use of resveratrol for osteogenic cell differentiation and mineralized bone formation. While these disclosures might lead one of skill in the art to try to treat diseases accompanied by a

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decrease in bone weight, such an "obvious to try" approach does not constitute *prima facie* obviousness. What is lacking in the present case is a reasonable expectation of success in modifying or combining teaching of the references to create the claimed invention. The references might lead one of skill in the art to believe that osteoblasts could be stimulated to produce additional bone tissue through the administration of resveratrol. However, one skilled in the art testing such a hypothesis would discover that bone density is not increased. See Table 1 of Applicants' specification at page 35. The same Table would show that breaking load and breaking energy are significantly higher in resveratrol-treated subjects than control. Such results could in no way be predicted by those having ordinary skill in the art. The CN1127070 reference would add nothing to alter this expectation. Accordingly, the reasonable expectation of success required to set forth a rejection under 35 U.S.C. § 103 is completely absent in the case of the presently claimed invention.

CONCLUSION

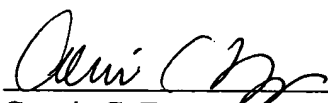
In view of the foregoing amendments and comments, it is respectfully submitted that the present application is fully in condition for allowance, and such action is earnestly solicited.

The undersigned has made a good faith effort to respond to all of the rejections in the case and to place the claims in condition for immediate allowance. Nevertheless, if any undeveloped issues remain or if any issues require clarification, the Examiner is respectfully invited to call the undersigned in order to resolve such issue promptly.

Respectfully submitted,

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